

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RALF BERSCHIED, HEINZ EGGENSBERGER,  
WOLFGANG BEILFUSS, SABINE BEHREND and BURGHARD PUCHSTEIN

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Appeal No. 2001-0427  
Application 08/860,007

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REMAND TO THE EXAMINER

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**MAILED**

**JAN 29 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before SCHEINER, ADAMS and MILLS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

In this case, we find it difficult to understand the examiner's reasoning with regard to the evidence relied upon to support the underlying fact findings for the rejections under 35 U.S.C. § 103. On this record, the examiner makes no effort to address the claims separately, or to address the specific limitations as they appear in each of appellants' claims. For example, claim 13 is drawn to a compound, wherein, inter alia, R<sub>4</sub> is chlorine; the composition of claim 8 requires that particular weight

percentages be met; and claim 21 is drawn to a shampoo or shower gel comprising, inter alia, "a re-fatting agent". However, none of these particular limitations are discussed by the examiner in any one of the prior art rejections of record.

In addition, while the examiner is short on identifying the facts necessary to establish a proper rejection under 35 U.S.C. 103, each of the examiner's prior art rejections provides a list of legal decisions, which according to the examiner support his position. However, as set forth in In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966), "it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103", Accord Ex parte Goldgaber, 41 USPQ2d 1172, 1176 (Bd. Pat. App. & Int. 1995)("each case under 35 U.S.C. § 103 is decided on its own particular facts."). On this record, the examiner has not addressed with any specificity how the facts in evidence on this record apply to appellants' claimed invention.

As set forth in Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997), "For an appellate court to fulfill its role of judicial review it must have a clear understanding of the grounds for the decision being reviewed," which requires that "[n]ecessary findings must be expressed with sufficient particularity to enable [the] court without resort to speculation, to understand the reasoning of the board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact-findings." Like the Court of Appeals in Gechter, this board requires a clear understanding of the grounds for the decision being reviewed.

Upon return of the application, the examiner should take a step back and reconsider the claimed invention in view of the evidence of record. If upon reconsideration, the examiner remains of the opinion that the claims on appeal are unpatentable, he should issue an appropriate Office action that sets forth the facts and reasons used in support of such a rejection. In addition, if the examiner maintains a rejection under 35 U.S.C. § 103, we suggest the examiner review MPEP § 706.02(j) for a model of how to explain a rejection under this section of the statute. Adherence to this model will of necessity require that the examiner consider the patentability of the claims in an individual manner and set forth the facts and reasons in support of why individual claims are unpatentable.

#### OTHER ISSUES

While we express no opinion on the merits of any rejection of record, we make the following observation in an effort to advance prosecution. According to the examiner claim 26 is indefinite, and is not enabled by the specification because the process set forth in claim 26 can not produce a product wherein "n is 2." Answer, pages 4-5. Appellants, however, believe that the specification, at page 9, sets forth a process which "demonstrates how to formulate compounds in which n is 2 using the method recited in claim 26." Brief, page 12. We note, however, that the process steps set forth in claim 26 are described at pages 7-8 of the specification, and produce a product of formula I, wherein  $n=1$ . As we understand the specification, the product of formula I, wherein  $n=1$ , can then be further processed to result in a product of formula I, wherein  $n=2$ . Specification, page 9.

The claim, however, appears to recite only the process steps set forth on pages 7-8 of the specification (which as discussed above, results in a product of formula I, wherein  $n=1$ ). In this regard we note that the last step of claim 26 requires that the 3 aryl-substituted propionic acid be reduced to form a desired alcohol of formula I. Accordingly, as we understand the invention, the claimed process results in an alcohol of formula 1, wherein  $n=1$ . Upon further prosecution, we encourage the examiner and appellants to work together to clarify the scope of claim 26.

We state that we are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner that contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED



Toni R. Scheiner  
Administrative Patent Judge



Donald E. Adams  
Administrative Patent Judge



Demetra J. Mills  
Administrative Patent Judge

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MANELLI DENISON & SELTER  
2000 M STREET NW SUITE 700  
WASHINGTON DC 20036-3307